

### III. REMARKS

1. Applicant respectfully traverses the Examiner's taking of Official Notice that the "background" inserted by caller or called party of Goldberg is equivalent with the "musical composition" representing the "affective state of the sender of the message of application." In accordance with M.P.E.P. § 2144.03, the Examiner is respectfully requested to provide an evidentiary basis for such Official Notice.

According to Applicant's claims, the caller or called party receiving the message "hears a musical composition" representing the affective state of the caller or called party sending the message. A "musical composition" as defined by Applicant encompasses "works that create in a listener an association with a certain emotion." (See e.g. page 2, lines 5-6). There is no such disclosure or teaching in Goldberg.

In Goldberg, a "background sound" is inserted in a telephone call between a calling party and a called party. (See e.g. Abstract, lines 1-2). This "background sound" of Goldberg is not the same as the "musical composition" claimed by Applicant. Goldberg describes the "sound heard in the background of the call" as "clinking glasses, music, loud talking." (Col. 1, lines 12-17). Other examples of "background sounds" include "restaurant sounds, forest sounds beach sounds, city traffic sounds, etc." (Col. 2, lines 48-50), or a "doorbell" (Col. 4, lines 49-50). Again, there is no disclosure here of a "musical composition that creates in the listener an associate with a certain emotion" as recited by Applicant in the claims and no such inference can be drawn from the disclosure of Goldberg. Any suggestion that the same can be inferred from or is taught by Goldberg could only be with hindsight knowledge of Applicant's disclosure, which is impermissible.

Furthermore, the claims of Applicant's disclosure are directed to a "musical composition" that represents the "affective state" of the caller or called party. Goldberg does not teach or even suggest this feature of Applicant's invention.

The "affective state" of a party as the term is used by Applicant relates to the "states of mind" or emotion of a person. (See e.g. page 2, lines 4-17). Different "affective states" can include for example, joy, depression (pg. 4, lines 9-10), excited (pg. 5, lines 14-15), fear and anxiety (pg. 5, line 26). The "affective state" generally relates to a "state of mind" (pg. 5, lines 30-31). An estimation based on this state of mind is used to select the "musical composition." (pg. 5, lines 31-34; See also description related to FIGS. 3, 4, 5, and 6, for example). Goldberg does not disclose or suggest this feature, and any inference that Goldberg does could only be with hindsight knowledge of Applicant's disclosure.

Goldberg deals only with "background sounds" that reflect the "locale" of the caller. Thus, Goldberg suggest sounds like restaurant sounds, forest sounds, beach sounds, city traffic sounds, etc. (Col. 2, lines 48-50). There is simply no disclosure in Goldberg, let alone any suggested or inferred relationships between the "background sounds" of Goldberg and "musical compositions" that reflect the "affective state" of a person of Applicant's claims.

Any suggestion or inference to this possibility could only be made with hindsight knowledge of Applicant's claims and disclosure, which as noted previously, is impermissible. The Examiner has not shown or produced any evidence that would or can be used to correlate "background sounds" of Goldberg, such as "restaurant sounds", to a "musical composition" representing the "affective state" of a person, as claimed by Applicant,

where the "affective state" corresponds to the "state of mind" or emotion of the person. It is respectfully submitted that the Examiner's taking of Official Notice that the "background sounds" of Goldberg are "equivalent" to the "musical composition" representing the "affective state" of the sender has no basis in fact, and it is merely with hindsight knowledge of Applicant's claims that such a statement is made. Evidentiary proof is requested to support this assertion.

Thus, it would not be obvious to one of skill in the art to modify Goldberg to provide a "musical composition representing the affective state of the caller or called party sending the message" as claimed by Applicant. Thus, claims 1 and 2 are not unpatentable over Goldberg under 35. U.S.C. § 103(a).

2. Claims 3-19 and 22 are not unpatentable over Goldberg in view of Cardina.

Claims 3-16 should be allowable at least by reason of their dependencies on claim 1. Claim 17 also deals with expressing an "affective state" of a caller, which as previously noted, is not disclosed or suggested by Goldberg. Cardina does not overcome at least these deficiencies and claim 17 should be allowable. Claim 22 should also be allowable at least by reason of its dependency.

3. Claims 20-21 are not unpatentable over Goldberg in view of Cardina and Armanto at least by reason of their dependencies.

4. Claim 23 is not unpatentable over Goldberg in view of Cardina and Makelaet at least by reason of its dependency.

Also, Makelaet is not prior art against Applicant's invention for purposes of 35 U.S.C. § 103(a). Makelaet is commonly owned by the assignee of the instant application, Nokia Mobile Phones,


Ltd., and only qualifies as art under 35 U.S.C. §102(e). Thus, pursuant to 35 U.S.C. § 103(c), Makelaet, is not prior art for purposes of 35 U.S.C. § 103 (a).

It is noted that this very same issue was addressed in Applicant's response of October 8, 2004. In fact, the instant Office Action bears a great degree of similarity, if not duplication, to the Office Action mailed July 28, 2004. Applicant does not believe it should be subjected to unnecessary prosecution and made to readdress issues that have previously be briefed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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10 April 2004  
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Date

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